

REMARKS

The examiner is thanked for the performance of a thorough search. No claims are canceled. Claims 20-31 are added. Hence, Claims 1-31 are pending. The amendments to the claims as indicated herein do not add any new matter to this application. Furthermore, amendments made to the claims as indicated herein have been made to exclusively improve readability and clarity of the claims and not for the purpose of overcoming alleged prior art. Each issue raised in the Office Action mailed October 23, 2007 is addressed hereinafter.

I. ISSUES NOT RELATING TO PRIOR ART

A. INFORMATION DISCLOSURE STATEMENT

An information disclosure statement is submitted herewith to cite the references identified in the specification at paragraph 10. Copies of the references are provided. Applicants respectfully request the Office to mail an initialed copy of Form SB-08 indicating consideration of the references with the next Office communication.

B. SPECIFICATION

The Office action objected to the specification. Paragraph 10 is amended herein to correct a citation error. Paragraph 75, 76, 79, 80, and 81 are amended to expand acronyms, to address statutory subject matter issues, and to address minor informalities. Reconsideration is respectfully requested.

C. CLAIMS 17-19—OBJECTIONS

The Office Action objected to claims 17-19 as reciting the term “for.” Applicants disagree and do not wish to limit the claims to anything not stated in the body of the claims. Therefore, claims 17-19 are amended to clarify that the only limitations are as stated in the body of the claims. Claims 17-19 also are voluntarily amended to recite the steps of claim 1 rather than referring back to multiple claims; new claims 20-31 introduce the subject matter of claims 2, 7, 9, and 10, but dependent upon claims 17-19, rather than referring back to these claims.

D. CLAIMS 1, 5, 16—SECTION 112 ISSUES

The Office Action rejected claims 1, 5, and 16 as allegedly indefinite.

Regarding claim 1, applicants disagree that “selectively” renders the claim indefinite, but solely to advance prosecution, “selectively” is deleted.

Paragraph 6 (page 4) of the Office Action refers to claim 1, but applicants believe that claim 5 was intended. Regarding claim 5, applicants disagree that “approximately” renders the claim indefinite, but solely to advance prosecution, “approximately” is deleted and “between 10^4 and 10^6 ” is substituted. Support is found in the specification at least at paragraph 43 (“a value of n on the order of 10^6 is expected to be sufficient for most applications for a long period of time”) when read in light of original claim 5.

Regarding claim 16, the term “the” is deleted in line 1.

Applicants believe that the present claims fully address all section 112 issues.

Reconsideration is respectfully requested.

E. CLAIM 19—SECTION 101 ISSUES

The Office Action rejected claim 19 under 35 U.S.C. 101 as allegedly directed to non-statutory subject matter. The specification is amended herein to describe computer-readable storage media and not transmission media. Claim 19 now recites storage media storing instructions. Therefore, Applicants believe that the present claims fully address all section 112 issues. Reconsideration is respectfully requested.

II. ISSUES RELATING TO PRIOR ART

A. CLAIMS 1, 17-19

Claims 1, 17-19 stand rejected under 35 U.S.C. § 102(c) as allegedly anticipated by Schuba U.S. Pat. No. 6,944,663. The rejection is respectfully traversed.

One feature recited in claim 1 is “receiving a request to access a resource from a user, wherein **the request includes an accumulated work value.**” An accumulated work value, not just an ordinary work value, is recited, and the accumulated work value is **in the request received from a user requesting access to a resource.**

For this feature, the Office Action relies on Schuba step 204, step 206, and col. 3 lines 53-58. This is incorrect. The work value identified in these parts of Schuba is **generated by the system**, not received in a user request. In step 202, Schuba’s process receives a user request, **and in response to the request the system generates a random number and selects a work value n** (steps 204-206; Schuba 3:50-58).

Clearly, Schuba’s process does not receive an accumulated work value in a user request. Instead, after receiving the request, the system generates a work value and ultimately provides the work value to the user. Schuba does not receive or use an accumulated work value at all. The claimed accumulated work value is different than a conventional work value, as clarified in original claim 16 (the accumulated work value “represents work that the resource has previously required the user to perform in order to obtain previous access to the resource”) and as extensively explained in applicants’ specification. The Office Action cannot properly interpret “accumulated work value” as the same as a conventional work value; the latter has no element of accumulation of work over time. Schuba has no way to receive any indication of what work the user has already done, in an initial user request for access to a resource.

The Office Action relies on the same parts of Schuba to allegedly anticipate the features of claim 1 of “determining an amount of accumulated work output value to provide to the user based on a volume of data communicated between the resource and the user; and providing the accumulated work output value to the user.” The position of the Office Action is legally incorrect. For a proper anticipation rejection, the cited reference must teach or disclose each and

every feature of the claims, **arranged as in the claims**. See *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Claim 1 recites five separate and different steps of receiving, determining, providing, determining and providing. The disclosure of Schuba is not “arranged as in the claims” because the same sections of Schuba cannot provide the five separate and different claimed steps. A skilled artisan would not interpret one statement in Schuba to provide two entirely separate and different claimed steps.

Further, Schuba column 3 does not describe determining an accumulated work output value **based on a volume of data communicated between the resource and the user**. Instead, the work value reflects an amount of work involved in computing a “preimage,” which is unrelated to data volume.

For at least these reasons, Schuba does not anticipate claim 1.

These differences between claim 1 and Schuba are not a matter of “interpreting” Schuba or the claims. Schuba is simply lacking multiple specifically claimed features and it is clear error to contend otherwise. Schuba merely represents a cumulative example of the old proof of work approach that is described and distinguished in the Background of applicants’ specification at paragraphs 3-5.

Claims 17-19 also include the same features described above for claim 1 that distinguishes claim 1 from Schuba, except that claims 17-19 are expressed in apparatus format and computer-readable storage medium format. For the same reasons set forth above for claim 1, Schuba does not anticipate claims 17-19. Reconsideration of claims 1 and 17-19 is respectfully requested.

B. CLAIMS 2 AND 3-16—SCHUBA, AND SCHUBA IN VIEW OF JUELS

Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schuba. The rejection is respectfully traversed.

Claim 2 depends from claim 1 and therefore claim 2 includes by dependency each of the features described in section A above that distinguish claim 1 from Schuba. The rationale of paragraph 12 of the Office Action only addresses the “prior user identity value” and “current user identity value” features of claim 2 and does not cure the deficiencies of Schuba with respect to the distinguishing features identified in section A. Therefore, Schuba in combination with the rationale of paragraph 12 of the Office Action cannot provide the complete subject matter recited in claim 2. Consequently, the Office Action does not establish a *prima facie* case of unpatentability of claim 2 in view of Schuba. Reconsideration is respectfully requested.

Claims 3-16 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schuba in view of Juels U.S. Pat. No. 7,197,639. The rejection is respectfully traversed.

Each of claims 3-15 depends from claim 1 and therefore includes by dependency each of the features described in section A above that distinguish claim 1 from Schuba. The description in Juels does not cure the deficiencies of Schuba with respect to the distinguishing features identified in section A. Further, Juels merely refers to “a secret password or other form of authentication” and not a “prior keyless user identity value” or a “one-time password,” and the non-specific description in Juels does not suggest the specific technique that is claimed. Therefore, Schuba in combination with Juels cannot provide the complete subject matter recited in claims 3-15. Consequently, the Office Action does not establish a *prima facie* case of unpatentability of claims 3-15 based on Schuba in view of Juels. Reconsideration is respectfully requested.

Claim 16 is independent and includes each of the features described in section A above that distinguish claim 1 from Schuba. Juels does not cure the deficiencies of Schuba with respect to the distinguishing features identified in section A. For example, Juels does not disclose receiving an accumulated work value **in the request**, as claimed—a feature completely ignored

by the Office Action in its discussion of claim 16. Claim 16 also recites “receiving a request to access a resource from a user, wherein the request includes an accumulated work value that represents work that the resource has previously required the user to perform in order to obtain previous access to the resource.” The Office Action relies on Juels 9:10-14, but this portion merely provides that different client puzzles of increasing size can be given to a client (not received from it in a request) as a server gets closer to a disabling condition. Juels 9:10-14 says nothing about **receiving an accumulated work value from a user or client**, as claimed, and says nothing about receiving a value that represents work the user previously had to do. In Juels, work previously done is not accounted for at all—only new work (client puzzles of increasing size) is handed out.

Therefore, Schuba in combination with Juels cannot provide the complete subject matter recited in claim 16. Consequently, the Office Action does not establish a *prima facie* case of unpatentability of claim 16 in view of Schuba. Reconsideration is respectfully requested.

C. NEW CLAIMS 20-31

New claims 20-31 correspond in scope to claims 2, 7, 9, and 10, but comprise three (3) sets of four (4) claims that are respectively dependent upon claims 19, 17 and 18. New claims 20-31 are allowable for the same reasons given above for claims 2, 7, 9, and 10. Favorable consideration is respectfully requested.

III. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed

herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any charge applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: January 23, 2008

/Christopher J. Palermo#42056/

Christopher J. Palermo

Reg. No. 42,056

2055 Gateway Place Suite 550
San Jose, California 95110-1093
Telephone No.: (408) 414-1080
Facsimile No.: (408) 414-1076